



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,558 ✓	03/21/2001	John T. Andrews	18433.00	2627

7590

04/14/2003

Richard C. Litman
LITMAN LAW OFFICES, LTD.
P.O. Box 15035
Arlington, VA 22215

EXAMINER

HO, THOMAS Y

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,558

Applicant(s)

ANDREWS ET AL.

Examiner

Thomas Y Ho

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-2, 4-5, 7, 11, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Klein USPN6419649.

As to claim 1, Klein discloses:

- A power source 13.
- A vibrating motor unit 14.
- A housing having a first 11b and second section 12 dimensioned and configured to contain said power source 13 and said vibrating motor unit 14.
- Each said first 11b and second sections 12 having mating ends 39 and 40 that connect to one another.
- Attachment means 26 for securing the vibrating body jewelry item to a body part of a user.
- A post 18.
- Said housing being disposed at one end of said post.
- Said attachment means being disposed at an opposite end of said post.

Art Unit: 3677

As to claim 2, Klein discloses a vibrating jewelry item wherein:

- Said power source is a battery 13.

As to claim 4, Klein discloses a vibrating jewelry item wherein:

- Said ends of said first 11b and second sections 12 of said housing have mating snap-fit structures 39 and 40 for connecting said sections together.

As to claim 5, Klein discloses a vibrating jewelry item wherein:

- Said second section 12 of said housing includes a recess.
- Said power source is a battery 13.
- Said battery being received on said recess (fig.5).

As to claim 7, Klein discloses a vibrating jewelry item wherein:

- Said attachment means for securing the vibrating body jewelry item to a body part of a user is a keeper 26.

As to claim 11, Klein discloses:

- A power source 13.
- A vibrating motor unit 14.
- A housing dimensioned and configured to contain said power source 13 and said vibrating motor unit 14.
- Attachment means 26 for securing the vibrating body jewelry item to a body part of a user.
- A post 18.
- Said housing being disposed at one end of said post.
- Said attachment means being disposed at an opposite end of said post.

Art Unit: 3677

- Said power source and said vibrating motor unit are disposed within said housing.

As to claim 13, Klein discloses a vibrating jewelry item wherein:

- Said attachment means includes a post 18 inserted through a wearer's pierced body part, and a keeper 26 to retain said item on the pierced body part.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein USPN6419649 in view of Riley USPN5048310.

As to claim 3, Klein fails to disclose or suggest:

- Said ends of said first and second sections of said housing include thread means for threadingly connecting said sections together.

It is commonly known that snap-fit structures and threaded members are equivalent means of securement. Riley discloses a jewelry apparatus wherein a snap-fit structure (fig.11) and a threaded fastener (fig.12) which are art recognized equivalents and interchangeable means of mounting one member onto another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the snap-fitted first and second sections disclosed by Klein to be threadingly connected, as taught by Riley, because they are equivalent means of connecting that are readily substitutable.

Art Unit: 3677

Riley discloses a keeper element 1 that also comprises a ring 4 (fig.1) useful for mounting of a decorative pendant therein (col.4, ln.32-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the keeper element disclosed by Klein to have a ring, as taught by Riley, to provide for the hanging of decorative pendants.

As to claim 14, Riley discloses:

- Said keeper comprises a ring.

Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein USPN6419649 in view of Yu USPN5688063.

As to claim 6, Klein discloses:

- Said post 18 has a threaded end and said housing 11b/12 has a threaded recess (near 20) defined in the second section.
- Said post extends through the threaded recess in the second section.

Klein fails to disclose or suggest:

- To move said power source onto said vibrating motor unit thereby activating said vibrating motor unit.

The examiner notes that the limitation “to move...motor unit” is functional language and does not hold patentable weight. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528, (Fed. Cir. 1990). Applicant is directed to MPEP 2114.

Art Unit: 3677

Yu discloses a post 61/72 that moves a power source 40 onto a vibrating motor unit 50 (col.2, ln.15-23), so the unit automatically turns on when the massager head is pressed (col.1, ln.27-35). The contact between the power source and motor unit consists of conductors. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the post disclosed by Klein to move the power source onto the vibrating motor unit, as taught by Yu, so the apparatus is automatically turned on only during use.

As to claim 12, Klein discloses a vibrating jewelry item wherein:

- Said post 18 has a threaded end and said housing has a threaded recess (near 20) formed therethrough.
- The threaded end extends through the threaded recess.

Yu discloses:

- To move said power source onto said vibrating motor unit thereby activating said vibrating motor unit.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein USPN6419649 in view of Erickson USPN4781036.

As to claim 8, Klein fails to disclose or suggest the following limitations:

- Said keeper is configured to receive an attachment selected from the group consisting of a chain, charm, and other ornamental jewelry piece item.

Erickson discloses a jewelry item wherein a keeper 18 is configured to receive a charm 20 to adjust to the mood of the wearer or the occasion (col.2, ln.1-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

Art Unit: 3677

keeper disclosed by Klein to be configured to receive a charm, as taught by Erickson, to adjust the jewelry item to the mood of the wearer or the occasion.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein USPN6419649 in view of Moody USPN4840045.

As to claim 9, Klein discloses a vibrating jewelry item wherein:

- Said attachment means for securing the vibrating body jewelry item to a body part of a user is a bar 18 and keeper 26.

Klein fails to disclose or suggest the following limitations:

- Said attachment means for securing is a clamp.

Moody discloses the use of a clamp as an attachment means for jewelry so jewelry can be worn in unpierced body parts (col.1, ln.18-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the attachment means disclosed by Klein with a clamp, as taught by Moody, to allow the jewelry to be worn on unpierced body parts.

As to claim 10, Moody discloses:

- Said clamping device includes a movable jaw and a fixed jaw.
- Said movable jaw mating with a stationary jaw to form said clamp device.

Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein USPN6419649 in view of Miceli USPN5140840.

As to claim 15, Klein discloses:

- A housing 11b/12 having a threaded recess (near 20) defined therein.
- A vibratory motor unit 14 disposed in the housing.

Art Unit: 3677

- A battery 13 disposed in the housing.
- The vibratory motor unit having a contact node depending therefrom.
- At least one post 18 having a threaded first end and having a second end.
- The first end being threaded into the recess defined in the housing.
- Attachment means 26 for securing the vibrating body jewelry item to a body part of a user.

Klein fails to disclose or suggest:

- A flexible cushioned barrier disposed between the vibratory motor unit and the battery 26.
- The post is movable between a first position in which the barrier separates the battery from the contact node in order to prevent the device from vibrating, and a second position in which the post forces the battery against the contact node in order to activate the vibratory motor unit.

Klein discloses a battery and a vibratory motor unit. Miceli discloses a flexible cushioned barrier 76 disposed between a powered output 10 and its power source (battery 26), with a post 92 movable between a first position (fig.5) in which the barrier separates the battery from the contact node 42 in order to activate the powered output, so power is only supplied when being worn (col.2, ln.5-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the vibratory motor unit and battery disclosed by Klein to have a flexible cushioned barrier between them, as taught by Miceli, so power is only supplied during times of use.

As to claim 16, Klein discloses:

Art Unit: 3677

- Said attachment means comprises a keeper 26.
- The device being adapted for attachment to a pierced body part with the post 18 extending through the body part.
- Said housing 11b/12 and said keeper being adapted for preventing the post from sliding through the body part.

Claims 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein USPN6419649 in view of Miceli USPN5140840, and further in view of Riley USPN5048310.

As to claim 17, Klein discloses:

- Said attachment means comprises a keeper 26.
- The device being adapted for attachment to a pierced body part with the post 18 extending through the body part.
- Said housing 11b/12 and said keeper being adapted for preventing the post from sliding through the body part.

Klein in view of Miceli fails to disclose or suggest:

- The keeper being ring-shaped.
- Said ring-shaped keeper being adapted for receiving a chain, a charm, and ornamental jewelry items.

Riley discloses a keeper element 1 that also comprises a ring 4 (fig.1) useful for mounting of a decorative pendant therein (col.4, ln.32-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the keeper element disclosed by Klein to have a ring, as taught by Riley, to provide for the hanging of decorative pendants.

Art Unit: 3677

It is commonly known that snap-fit structures and threaded members are equivalent means of securement. Riley discloses a jewelry apparatus wherein a snap-fit structure (fig.11) and a threaded fastener (fig.12) which are art recognized equivalents and interchangeable means of mounting one member onto another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the snap-fitted first and second sections disclosed by Klein to be threadingly connected, as taught by Riley, because they are equivalent means of connecting that are readily substitutable.

As to claim 20, Klein discloses:

- Said housing 11b/12 has a first section 11b and a second section 12.

Riley discloses:

- The first and second sections having mating male and female threaded connectors.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein USPN6419649 in view of Miceli USPN5140840, and further in view of Chiang USPN5484390.

As to claim 18, Klein in view of Miceli fails to disclose or suggest:

- Said attachment means comprises a clamp having a fixed jaw and a movable jaw pivotally attached to the fixed jaw.
- The clamp being adapted for attachment to a body part.

Chiang discloses an attachment means comprising a clamp 3 having a fixed jaw 32 and a movable jaw 31 pivotally attached to the fixed jaw (col.2, ln.29-36), with the clamp being adapted for attachment to a body part, so a massage device can be used on a specific portion of the body (col.1, ln.1-14). It would have been obvious to one of ordinary skill in the art at the

Art Unit: 3677

time the invention was made to modify the attachment means disclosed by Klein to be a clamp, as taught by Chiang, so the device can massage a specific portion of the body.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein USPN6419649 in view of Miceli USPN5140840, and further in view of Chiang USPN5484390, and further in view of Riley USPN5048310.

As to claim 19, Klein discloses:

- A first post 18.
- The attachment means comprising a keeper 26.
- The device being adapted for attachment to a pierced body part.
- A second post 18.
- A third post 18.
- Said first, second and third posts are interchangeably attached to said housing 11b/12 in order to attach the device to a body part, whether the body part is pierced or unpierced.

Klein in view of Miceli fails to disclose or suggest:

- Attachment means comprising a clamp having a fixed jaw 32 and a movable jaw 31 pivotally attached to the fixed jaw.
- The device being adapted for attachment to a body part.
- Attachment means comprising a ring adapted for receiving an ornamental jewelry attachment.

Chiang discloses an attachment means comprising a clamp 3 having a fixed jaw 32 and a movable jaw 31 pivotally attached to the fixed jaw (col.2, ln.29-36), with the clamp being

Art Unit: 3677

adapted for attachment to a body part, so a massage device can be used on a specific portion of the body (col.1, ln.1-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the attachment means disclosed by Klein to be a clamp, as taught by Chiang, so the device can massage a specific portion of the body.

Riley discloses a keeper element 1 that also comprises a ring 4 (fig.1) useful for mounting of a decorative pendant therein (col.4, ln.32-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the keeper element disclosed by Klein to have a ring, as taught by Riley, to provide for the hanging of decorative pendants.

Response to Arguments

The rejections under 35 USC 112 1st and 2nd paragraphs have been withdrawn in light of the correction submitted in the amendment filed 2/3/03.

Applicant's failure to file a timely section 131 declaration to swear behind the Klein reference resulted in the Klein reference maintaining status of being prior art.

Applicant's arguments with respect to claims 1, 6, 11-12, and 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN3750655 to Kolbel discloses a vibration massaging device with a clamp.

USPN4459645 to Glatter discloses an illuminating earring.

USPN5622062 to Gong-Hwa discloses a ring with sound and light.

USPN5683421 to Guarini discloses a teething apparatus.

Art Unit: 3677

USPN5693073 to Glick discloses a vibrating pacifier.

USPN6158439 to Streetman discloses a vibrating mouthpiece.

USPN6193742 to Moriarty discloses a pacifier with motion generator.

USPN6203509 to Duboff discloses a fingertip massager.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Application/Control Number: 09/812,558


Page 14

Art Unit: 3677

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-1113.

TYH

April 4, 2003


ROBERT J. SANDY
PRIMARY EXAMINER